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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,031

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Nobuyuki Takakuwa

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08/04/2009

YOUNG & THOMPSON

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EXAMINER

SHIBRU, HELEN

ART UNIT

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2621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,031	TAKAKUWA ET AL.	
	Examiner	Art Unit	
	HELEN SHIBRU	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/18/06,04/01/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 21-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato (US PG PUB 2007/0286577).

Regarding claim 21, Kato discloses an information record medium on which there are recorded: a series of content information (see paragraphs 0183, 0265, content information is generated); menu information as for said content information, which is to be displayed with said content information during reproduction of said content information (see paragraphs 0255 and figure 14); and play list information for defining reproduction sequence of said content information by a unit of item, which constitutes said content information and which is accessible upon reproducing (see figure 14, playlist, paragraphs 0257-0258, and 0307-0308), said play list information including: item information for specifying each item which constitutes said content information (see paragraphs 0187, 0308 and figure 2); and slave item information for specifying said menu information as a slave item (see paragraphs 0505-0506 and 0534-0535).

Regarding claim 22, Kato discloses menu information is displayed with being superimposed on or in place of one portion of said content information or is not displayed at all (see paragraphs 0506 and 0535).

Regarding claim 23, Kato discloses menu information specified by the slave item information is further recorded in said play list information, as common information commonly used by a plurality of slave items (see paragraphs 0226 and 0230).

Regarding claim 24, Kato discloses there is further recorded reproduction control information for controlling such that said menu information specified by the slave item information is displayed with being superimposed on or in place of one portion of said content information corresponding to said menu information specified by the slave item information or is not displayed at all (see paragraphs 0534-0556).

Regarding claim 25, Kato discloses an information record apparatus, comprising: a first record device for recording a series of content information and menu information as for said content information, which is to be displayed with said content information during reproduction of said content information (see paragraphs 0187, 0192, controller 23 in figure 1); and a second record device for recording play list information for defining reproduction sequence of said content information by a unit of item, which constitutes said content information and which is accessible upon reproducing (see paragraphs 0190, 0196, 0607 and claim 21 rejection above), said second record device recording said play list information such that said play list information includes: item information for specifying each item which constitutes said content information; and slave item information for specifying said menu information as a slave item (see claim 21 rejection above).

Claim 26 is rejected for the same reasons as discussed in claim 25 above.

Regarding claim 27, Kato discloses information reproduction apparatus comprising: a reproduction device (see figure 1 recording and/or reproducing apparatus and unit 28) capable of

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reproducing said content information, said menu information and said play list information (see rejection of claim 21 above); a displaying and outputting device (see input/output device in figure 1) capable of displaying and outputting said content information and said menu information (see rejection of claim 21 above); and a control device (see controller 23 in figure 1) for controlling said reproduction device to reproduce said content information and said menu information, in accordance with the item information and the slave item information included in said play list information reproduced by said reproducing device (see rejection of claim 21 above).

Regarding claim 28, Kato discloses a buffer memory for maintaining said reproduced menu information in a readily displayable and outputtable condition, for a predetermined period, regardless of whether or not said reproduced menu information is displayed and outputted by said displaying and outputting device (see paragraphs 0506 and 0535, it is inherent that the menu is displayed only for a predetermined time).

Regarding claim 29, the limitation of claim 29 can be found in claims 21 and 25. Therefore claim 29 is analyzed and rejected for the same reasons as discussed in claims 21 and 25 above.

Regarding claim 30, the limitation of claim 30 can be found in claims 21 and 25. Therefore claim 30 is analyzed and rejected for the same reasons as discussed in claims 21 and 25 above.

Regarding claim 31, the limitation of claim 31 can be found in claims 21 and 25. Therefore claim 31 is analyzed and rejected for the same reasons as discussed in claims 21 and 25 above.

Regarding claim 32, Kato discloses a computer program for a record control to control a computer disposed at the information record apparatus the said program making the computer function as at least a part of the first record device and the second record device (see paragraphs 0520 and 0583).

Regarding claim 33, Kato discloses the said program making the computer function as at least a part of the reproduction device, the displaying and outputting device and the control device (see figure 54 and paragraphs 0533-0565).

Regarding claim 34, Kato discloses the said program making the computer function as at least a part of the first record device, the second record device, the reproduction device, the displaying and outputting device and the control device (see figure 54 and paragraphs 0533-0565).

Regarding claim 35, the limitation of claim 35 can be found in claim 21. Therefore claim 35 is analyzed and rejected for the same reasons as discussed in claim 21 above.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 32-35 are rejected under 35 U.S.C. 101 because the claims are directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a

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computer-readable medium does not make it statutory. In addition a mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship either as part of the stored data or as part of the computing processes performed by the computer then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer, and therefore are not statutory. See MPEP 2106.IV.B.1.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21, 25-27, 29-35 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 10, and 15-21 of copending Application No. 11/147,242. Although the conflicting claims are not

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identical, they are not patentably distinct from each other. See the reasons sets forth below.

Regarding claim 21, the copending application claim 1 recites an information record medium on which there are recorded: a series of content information; menu information as for said content information, which is to be displayed with said content information during reproduction of said content information; and play list information for defining reproduction sequence of said content information by a unit of item, which constitutes said content information and which is accessible upon reproducing, said play list information including: item information for specifying each item which constitutes said content information; and slave item information for specifying said menu information as a slave item.

Regarding claim 25, the copending application claim 8 recites an information record apparatus, comprising: a first record device for recording a series of content information and menu information as for said content information, which is to be displayed with said content information during reproduction of said content information; and a second record device for recording play list information for defining reproduction sequence of said content information by a unit of item, which constitutes said content information and which is accessible upon reproducing, said second record device recording said play list information such that said play list information includes: item information for specifying each item which constitutes said content information; and slave item information for specifying said menu information as a slave item.

Regarding claim 26, the copending application claim 9 recites an information record method, comprising: a first record process of recording a series of content information and menu

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information as for said content information, which is to be displayed with said content information during reproduction of said content information; and a second record process of recording play list information for defining reproduction sequence of said content information by a unit of item, which constitutes said content information and which is accessible upon reproducing, said second record process recording said play list information such that said play list information includes: item information for specifying each item which constitutes said content information; and slave item information for specifying said menu information as a slave item.

Regarding claim 27, the copending application claim 10 recites an information reproduction apparatus for reproducing said information record medium according to claim 1, said information reproduction apparatus comprising: a reproduction device capable of reproducing said content information, said menu information and said play list information; a displaying and outputting device capable of displaying and outputting said content information and said menu information; and a control device for controlling said reproduction device to reproduce said content information and said menu information, in accordance with the item information and the slave item information included in said play list information reproduced by said reproducing device.

Regarding claim 29, the copending application claim 15 recites an information reproduction method of reproducing said information record medium according to claim 1 on an information reproduction apparatus comprising: (i) a reproduction device capable of reproducing said content information, said menu information and said play list information; and (ii) a displaying and outputting device capable of displaying and outputting said content information

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and said menu information, said information reproduction method comprising: a first control process of controlling said reproducing device to reproduce said play list information; and a second control process of controlling said reproducing device to reproduce said content information and said menu information, in accordance with the item information and the slave item information included in said play list information reproduced by said reproducing device.

Regarding claim 30, the copending application claim 16 recites an information record reproduction apparatus, comprising: a first record device for recording a series of content information and menu information as for said content information, which is to be displayed with said content information during reproduction of said content information; a second record device for recording play list information for defining reproduction sequence of said content information by a unit of item, which constitutes said content information and which is accessible upon reproducing, said second record device recording said play list information such that said play list information includes: item information for specifying each item which constitutes said content information; and slave item information for specifying said menu information as a slave item; a reproduction device capable of reproducing said content information, said menu information, and said play list information; a displaying and outputting device capable of displaying and outputting said content information and said menu information; and a control device for controlling said reproduction device to reproduce said content information and said menu information, in accordance with the item information and the slave item information included in said play list information reproduced by said reproducing device.

Regarding claim 31, the copending application claim 17 recites an information record reproduction method on an information reproduction apparatus comprising: (i) a reproduction

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device capable of reproducing content information, menu information and play list information; and (ii) a displaying and outputting device capable of displaying and outputting said content information and said menu information, said information record reproduction method comprising: a first record process of recording a series of content information and menu information as for said content information, which is to be displayed with said content information during reproduction of said content information; a second record process of recording play list information for defining reproduction sequence of said content information by a unit of item, which constitutes said content information and which is accessible upon reproducing, said second record process recording said play list information such that said play list information includes: item information for specifying each item which constitutes said content information; and slave item information for specifying said menu information as a slave item; and a first control process of controlling said reproducing device to reproduce said content information and said menu information, in accordance with the item information and the slave item information included in said play list information reproduced by said reproducing device.

Regarding claim 32, the copending application claim 18 recites a computer program for a record control to control a computer disposed at the information record apparatus according to claim 8, said program making the computer function as at least a part of the first record device and the second record device.

Regarding claim 33 the copending application claim 19 recites a computer program for a reproduction control to control a computer disposed at the information reproduction apparatus according to claim 27, said program making the computer function as at least a part of the reproduction device, the displaying and outputting device and the control device.

Regarding claim 34 the copending application claim 20 recites a computer program for a record reproduction control to control a computer disposed at the information record reproduction apparatus according to claim 31, said program making the computer function as at least a part of the first record device, the second record device, the reproduction device, the displaying and outputting device and the control device.

Regarding claim 35 the copending application claim 21 recites a data structure including a control signal, comprising a series of content information; menu information as for said content information, which is to be displayed with said content information during reproduction of said content information; and play list information for defining reproduction sequence of said content information by a unit of item, which constitutes said content information and which is accessible upon reproducing, said play list information including: item information for specifying each item which constitutes said content information; and slave item information for specifying said menu information as a slave item.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. Claims 22-24 and 28 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 11/147,242 in view of Kato (US PG PUB 2007/0286577).

Claim 28 will be discussed first.

Although the copending application claim 10 recites the limitation of claim 27, the copending application fails to teach a buffer memory for maintaining said reproduced menu information in a readily displayable and outputtable condition, for a predetermined period,

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regardless of whether or not said reproduced menu information is displayed and outputted by said displaying and outputting device.

In the same field of endeavor Kato discloses a buffer memory for maintaining said reproduced menu information in a readily displayable and outputtable condition, for a predetermined period, regardless of whether or not said reproduced menu information is displayed and outputted by said displaying and outputting device (see paragraphs 0506 and 0535, it is inherent that the menu is displayed only for a predetermined time). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the copending application by providing a buffer memory to display a menu for a predetermined time in order to provide the user the opportunity to select a desired content.

Regarding claim 22, Kato discloses menu information is displayed with being superimposed on or in place of one portion of said content information or is not displayed at all (see paragraphs 0506 and 0535).

Regarding claim 23, Kato discloses menu information specified by the slave item information is further recorded in said play list information, as common information commonly used by a plurality of slave items (see paragraphs 0226 and 0230).

Regarding claim 24, Kato discloses there is further recorded reproduction control information for controlling such that said menu information specified by the slave item information is displayed with being superimposed on or in place of one portion of said content information corresponding to said menu information specified by the slave item information or is not displayed at all (see paragraphs 0534-0556).

This is a provisional obviousness-type double patenting rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/
Examiner, Art Unit 2621
July 30, 2009

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621